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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,488	05/24/2001	Marcia A. Wise	7733.D2	3552
7590 03/25/2011 FAY KAPLUN AND MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			EXAMINER GRAY, PHILLIP A	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 03/25/2011	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCIA A. WISE and H. ROBERT MOOREHEAD

Appeal 2009-009933
Application 09/864,488
Technology Center 3700

Before WILLIAM F. PATE, III, JOHN C. KERINS, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Marcia A. Wise and H. Robert Moorehead (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's non-final rejection¹ of claims 56, 59-66, 68-72 and 74-81. Claims 1-54 were previously canceled, and claims 55, 57, 58, 67 and 73 have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a system for establishing intermittent fluid communication with a patient's bloodstream. Claim 56, reproduced below, is illustrative of the claimed subject matter:

56. A system for establishing intermittent fluid communication with a patient's bloodstream, comprising:

a catheter including first and second lumens extending therethrough from a proximal end of the catheter to a distal end thereof, wherein, when in an operative position, the distal end of the catheter resides within a blood vessel of a patient; and

a first sealing balloon positionable within a distal end of the first lumen, so that, when inflated, the first balloon seals the distal end of the first lumen to prevent blood flow thereinto; and

a deflation mechanism for deflating the first balloon to reopen the first lumen to blood flow

¹ Non-final Office Action dated March 9, 2007, reopening prosecution subsequent to the Appeal Brief filed August 22, 2006. Reference to the Appeal Brief herein is to the Appeal Brief filed April 23, 2008.

thereinto while the distal end of the catheter remains within the blood vessel.

THE REJECTIONS

The Examiner has rejected:

(i) claims 56, 59-66, 68, 69 and 80 under 35 U.S.C. § 102(b) as being anticipated by Wijay (US 5,158,540, issued October 27, 1992);

(ii) claims 56, 59-66, 68, 69 and 80 under 35 U.S.C. § 102(b) as being anticipated by Horzewski (US 4,771,777, issued September 20, 1988);

(iii) claims 56, 59-66, 68, 69 and 80 under 35 U.S.C. § 102(b) as being anticipated by Cannon (US 5,403,274, issued April 4, 1995);

(iv) claims 59-64 under 35 U.S.C. § 102(b) as being anticipated by Wijay, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Wijay in view of Burns (US 5,176,698, issued January 5, 1993); and

(v) claims 70-72, 74-79 and 81 under 35 U.S.C. § 103(a) as being unpatentable over each of Wijay, Horzewski, Cannon and Calderon (US 4,867,742, issued September 19, 1989).

The Examiner withdrew, on appeal, a rejection of claim 56 under 35 U.S.C. § 112, second paragraph, and a rejection of claims 56, 59-66, 68, 69 and 80 under 35 U.S.C. § 102(b) as being anticipated by Calderon. (Ans. 3).

ISSUES

Did the Examiner err in finding that any of Wijay, Horzewski, or Cannon discloses all elements of claims 56, 59-66, 68, 69 and 80?

Did the Examiner err in concluding that Wijay and Burns render obvious the subject matter of claims 59-64?

Did the Examiner err in concluding that each of Wijay, Horzewski, Cannon and Calderon renders obvious the subject matter of claims 70-72, 74-79 and 81?

ANALYSIS

Claims 56, 59-66, 68, 69 and 80--Anticipation by Wijay

Appellants argue that claim 56 is not anticipated by Wijay because Wijay does not disclose ““a first sealing balloon positionable within a distal end of the first lumen, so that, when inflated, the first balloon seals the distal end of the first lumen to prevent blood flow thereinto””. (Appeal Br. 9, quoting from claim 56). Appellants contend that balloon 16 is not located or locatable at a distal end of annular passage 30. (*Id.*). Appellants characterize balloon 16 as being “positioned along a length of the annular passage 30 spaced from a distal end thereof to seal off the annular passage for distal hemoperfusion.” (*Id.*).

The Examiner’s position is that balloon 16 seals the distal end of passage 30, with the distal end being the portion of the passage located downstream of the 3-3 section line in Figure 1. (Ans. 7). Giving the claim term “distal end” its broadest reasonable meaning, we do not find error with the Examiner’s position as to what constitutes the distal end.

Furthermore, to the extent that Appellants would assert that the claimed distal end must include the distal tip or distal-most extent of the passage², we note that claim 56 requires only that the first sealing balloon be “positionable” within a distal end to prevent blood flow into the lumen. The suffix “-able” indicates in English that the word so modified “is capable of”.

² Appellants do not appear to take this position in arguing the anticipation rejections over Horzewski and Cannon.

Consequently, “positionable” connotes that the first sealing balloon is capable of being positioned at the claimed location. Thus, even if Figure 1 of Wijay were regarded as not illustrating balloon 16 within the distal end of passage 30, it appears that balloon 16 would be capable of being positioned at the distal-most extent of passage 30, despite Appellants’ protestation to the contrary. As such, Wijay discloses the claimed feature. *In re Collier*, 397 F.2d 1003, 1006 (CCPA 1968)(crimpable ferrule or connector member was not required, structurally, to be crimped).

For the remaining independent claims subject to this ground of rejection, i.e., claims 59, 64, 65 and 80, Appellants simply quote selected language from these claims and state that those claims are “allowable for at least the same reasons as claim 56.” (Appeal Br. 11-12). Dependent claims 60-63, 66, 68 and 69 are not separately argued.

As discussed above, we are not persuaded that claim 56 is allowable over Wijay. Furthermore, statements which merely point out what a claim recites are not regarded as arguments for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). We will thus sustain the anticipation rejection in view of Wijay for all of claims 56, 59-66, 68, 69 and 80 subject to the rejection.

Claims 56, 59-66, 68, 69 and 80--Anticipation by Horzewski

Appellants contend that Horzewski does not anticipate claim 56 because: (1) only one lumen extends from the proximal to distal end of the catheter, because tubular membrane 77 of Horzewski “does not share proximal and distal ends with the tubular member 14” and thus does not extend through the catheter from a proximal to a distal end; and (2) Horzewski does not teach a balloon sealing the distal end of a first lumen to

prevent blood flow thereinto, because the Horzewski device allows blood to flow through its dilatation catheter into a region beyond a stenosis being treated. (Appeal Br. 12-13).

We are not persuaded by argument (1) above. We see no requirement in claim 56 that the tubular membrane 77 corresponding to the element having the second lumen therein must share the same proximal and distal ends as catheter 12 having the first lumen therein. Both the first and second lumens within elements 12 and 77 extend from a proximal to a distal end of catheter 12, as claimed. (Horzewski, Fig. 9).

Argument (2) fails to persuade us of the novelty of claim 56 as well. While balloon 82 does not prevent blood flow through a lumen in tubular membrane 77, as noted by Appellants, balloon 82 does prevent blood flow into the lumen (thereinto, per claim 56) of catheter 12, a point not contested by Appellants. (Ans. 8, *citing* Horzewski, col. 7, ll. 19-21; *see also* Horzewski, Fig. 9).

For the remaining independent claims subject to this ground of rejection, i.e., claims 59, 64, 65 and 80, Appellants simply quote selected language from these claims and state that those claims are “allowable for at least the same reasons as claim 56.” (Appeal Br. 14-15). Dependent claims 60-63, 66, 68 and 69 are not separately argued.

As discussed above, we are not persuaded that claim 56 is allowable over Horzewski. Furthermore, statements which merely point out what a claim recites are not regarded as arguments for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). We will thus sustain the anticipation rejection in view of Horzewski for all of claims 56, 59-66, 68, 69 and 80 subject to the rejection.

Claims 56, 59-66, 68, 69 and 80--Anticipation by Cannon

Appellants argue that Cannon does not disclose a balloon sealing the distal end of a first lumen to prevent blood flow thereinto, because the Cannon device, even with balloon 44 inflated, an injection port 32 of the second lumen is always in fluid communication with the blood vessel, via opening 48 which opens into the first lumen. (Appeal Br. 19). The blood entering port 32 flows through the balloon lumen past the inflated balloon 44 and out opening 34 at the distal end of the balloon catheter. (Cannon, Fig. 3). This, according to Appellants, means that the balloon 44 does not seal the distal end of the first lumen to prevent blood flow thereinto. (Appeal Br. 18-19).

Keeping in mind that the first lumen in Cannon is, in the Examiner's findings, the opening through catheter 12, Cannon specifically states that, "the inflation of the trapper balloon 44 effectively seals the distal end of the guide catheter, as may be seen in FIGS. 2, 3, and 5." (Cannon, col. 5, ll. 58-61). As such, the balloon will prevent blood flow into the distal end of the lumen. That blood may flow into the lumen through opening 48 at a point inboard of the distal end, and through a port into the second lumen, does not compel a finding that the inflated balloon does not seal the distal end and does not prevent blood flow into the sealed-off distal end. We are not persuaded of error in the Examiner's findings in this respect.

For the remaining independent claims subject to this ground of rejection, i.e., claims 59, 64, 65 and 80, Appellants simply quote selected language from these claims and state that those claims are "allowable for at least the same reasons as claim 56." (Appeal Br. 19-21). Dependent claims 60-63, 66, 68 and 69 are not separately argued.

As discussed above, we are not persuaded that claim 56 is allowable over Cannon. Furthermore, statements which merely point out what a claim recites are not regarded as arguments for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). We will thus sustain the anticipation rejection in view of Cannon for all of claims 56, 59-66, 68, 69 and 80 subject to the rejection.

Claims 59-64--§ 102 or § 103--Wijay or Wijay/Burns

Appellants contend that Burns does not remedy the alleged deficiencies in Wijay (discussed above in the anticipation rejection in view of Wijay), and thus Wijay and Burns, taken alone or in combination, do not show or suggest inflating a first balloon to seal the first lumen at the distal end thereof to prevent fluid from entering the distal end. (Appeal Br. 21). As noted above, we do not agree with what Appellants regard as deficiencies in the Wijay reference, namely that the balloon 16 in Wijay is not inflated at a distal end of the first lumen. Accordingly, we are not persuaded that Wijay is deficient in the manner alleged by Appellants.

For the other independent claim subject to this ground of rejection, i.e., claim 64, Appellants simply quote selected language from this claim and state that the claim is allowable “at least for the reasons described above with respect to claim 59.” (Appeal Br. 22). Dependent claims 60-63 are not separately argued.

We will thus sustain the rejection of claims 59-64 as anticipated by Wijay, or as rendered obvious by Wijay and Burns.

Claims 70-72, 74-79 and 81--§ 103--Wijay, Horzewski, Cannon, Calderon

Appellants present the same arguments for the patentability of independent claim 70 as were presented in connection with claim 56 in

opposition to the anticipation rejections in view of Wijay, Horzewski and Cannon. (Appeal Br. 22-27). For the same reasons presented above as to the lack of persuasiveness of those arguments, we will sustain the rejection of claim 70 as being obvious in view of each of these references. Claims 71, 72, 74-79 and 81 are not separately argued, and thus fall with claim 70.

The rejection of these claims as being obvious in view of Calderon relies on findings made initially by the Examiner in rejecting other claims, including claim 56, as being anticipated by Calderon. That anticipation rejection has been withdrawn, and the instant rejection is thus not supported by adequate findings in order to conclude that claims 70-72, 74-79 and 81 would have been obvious over Calderon. This rejection will thus not be sustained.

CONCLUSIONS

The Examiner was not shown to have erred in finding that each of Wijay, Horzewski, and Cannon discloses all elements of claims 56, 59-66, 68, 69 and 80.

The Examiner was not shown to have erred in concluding that Wijay and Burns render obvious the subject matter of claims 59-64.

The Examiner was not shown to have erred in concluding that each of Wijay, Horzewski, and Cannon renders obvious the subject matter of claims 70-72, 74-79 and 81. The Examiner did err in concluding that the subject matter of claims 70-72, 74-79 and 81 was rendered obvious by Calderon.

DECISION

The decision of the Examiner to reject claims 56, 59-66, 68-72 and 74-81 is **AFFIRMED**.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG